



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,602	10/17/2003	Mitsuru Naito	OGW-0294	9370
23353	7590	03/11/2005	EXAMINER	
RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036			TANG, SON M	
			ART UNIT	PAPER NUMBER
			2632	

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/686,602

Applicant(s)

NAITO, MITSURU

Examiner

Son M Tang

Art Unit

2632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/17/03 & 12/5/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/686,635. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed of support core member is formed in a channel hollow and the position of a device, can be written in a broadly terms which simplified the claim structure, but the functionality remains the same. Therefore, one having ordinary skill in the art would have found it obvious to modify the structure of a limitation in the simplify form, and not distinction the functionality.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karbo et al. [US 4,160,234; Karbo].

Regarding to claim 1: Karbo discloses a mounting structure of a tire monitoring device in which the tire monitoring device 30 transmitting information of an inside of a tire by using radio waves is mounted on a support core member 26 placed within a cavity of a pneumatic tire, wherein a transmission antenna 28 of the tire monitoring device is disposed on a load support in a peripheral portion of the support core member [see Fig. 2-4, col. 3, lines 48-64], Karbo further discloses that antenna follows the contour of the support core member and molded integrally with support core member [col. 3, lines 60-64], Karbo does not specifically discloses that antenna disposed on or in a load support surface of the support core member. In reflection of statement of Karbo above about antenna location, it would have been obvious of one having ordinary skill in the art would motivate to dispose antenna on the surface of support core member, for the benefit of less labor which is easy to dispose antenna on the surface than inside.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karbo et al. in view of Piesinger [US 2003/0038716].

Art Unit: 2632

Regarding to claim 2: Karbo disclose all the limitation as described in claim above, except for specifically discloses the antenna insulated cover. An insulating cover for antenna of a tire monitoring is known in the art, Piesinger teaches a tire monitor 12 includes an insulated antenna 25 [see ¶ 0020]. It would have been obvious of one having ordinary skill in the art at the time of the claimed invention, to have an insulating cover for transmitter antenna as suggested by Piesinger, for the benefit of protection and prevent interference.

6. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karbo et al. in view of Beckly [2003/0156024].

Regarding to claims 3-4: Karbo disclose all the limitation as described in claim above, except for specifically discloses the antenna is formed in a film shape. It is known in the art that, film shape is one of variety type of antenna use in tire monitor device, Beckly teaches a tire monitoring device comprises an antenna is formed as a relative thin structure [as cited in ¶ 0005] which constitutes of film shape antenna. Therefore, it would have been obvious of one having ordinary skill in the art at the time of the claimed invention, to combine film shape antenna of Beckly with Karbo for the benefit of better for installation, since film shape antenna is thin and flexible.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hamaya [US 5,960,844], Fortune et al. [US 6,016,102], Latarnik et al. [US 6,822,561], Nantz et al. [US 2003/0164799A1] and Dinello et al. [US 2004/0212486A1].

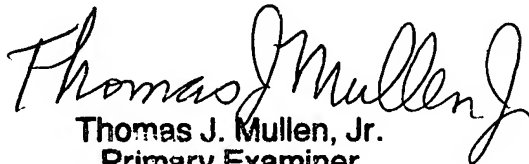
Art Unit: 2632

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son M Tang whose telephone number is (571)272-2962. The examiner can normally be reached on 4/9 First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel J Wu can be reached on (571)272-2964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Son Tang


Thomas J. Mullen, Jr.
Primary Examiner
Art Unit 2632